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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,512	03/02/2004	Thomas C. Muehlenbeck	7328.3001.001	2764

7590 10/15/2004

REISING, ETHINGTON, BARNES,
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EXAMINER

PRICE, RICHARD THOMAS JR

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,512	MUEHLENBECK, THOMAS C. <i>CG</i>	
	Examiner Thomas Price	Art Unit 3643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 02 March 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-10 is/are pending in the application.

4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-7 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>05-26-2004</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a pin bone remover, classified in class 452, subclass 103.
- II. Claims 8-10, drawn to a method of making a fish pin bone remover, classified in class 452, subclass 103.

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, various sized and shaped knives.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Farris on October 08, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman U.S. Patent 1,226,797.

Newman teaches a fruit knife which is structurally similar to the Applicant's claimed fish pin bone remover. More specifically, the apparatus of Newman includes a blade member 11, as seen in Figures 1-4, including a left leg 12 with a left inside edge and a left outside edge (see Figure 3). The blade member 11 further includes a right leg 13 having a right inside edge and a right outside edge (see Figure 3). A bridge portion 10 is integral with a left leg inner end and a right leg inner end and further including an arcuate inside edge and an arcuate outside edge. As seen in Figures 3 and 4, a cutting edge is formed continuously about the left leg, the right leg and the bridge about the inside edge and outside edge. A handle 9 is fixed to a free left end of the left leg and to a free right end of the right leg. However, Newman does not discuss how the edge is formed. Regarding claim 1, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form a cutting edge by grinding the metal blade member, in that grinding is a well-known and widely used method of forming a cutting edge in a metal material. In regards to claim 2, as seen in Figure 3, the distance from the outside edge of the right and left leg of the blade member exceeds the width of

the space between the left cutting edge portion and the right cutting edge portion. As for claim 4, the left outside edge of the left leg is substantially parallel to the right outside edge of the right leg, see Figure 2. Regarding claim 5, the left outside edge of the left leg is substantially parallel to the left cutting edge portion, and the right outside edge of the right leg is substantially parallel to the right cutting edge portion, see Figure 2.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newman U.S. Patent 1,226,797 in view of Lee U.S. Patent 2,142,197.

Newman does not discuss nor teach a tip surface extending at about 45 degrees or between 35 and 55 degrees. Lee teaches a knife having two parallel blades and a tip surface extending about 45 degrees, see Figure 3. Regarding claims 3 and 7, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the tip surface of Newman, to extend about 45 degrees, in view of the teachings of Lee, in order to allow the device to be plunged into that which is being cut.

Prior Art of Record

The prior art of record have been cited as similar references that show parallel cutting knives with their related features, such as an angled tip surface, cutting edges and method of use.

Information Disclosure Statement

The Information Disclosure Statement filed on May 26, 2004 is considered, all references have been reviewed and initialed. A photo copy of the IDS PTO-1449 is attached herewith.

Conclusion

Summary: Claims 8-10 were withdrawn as claims being directed to a non-elected invention, which claims 1-7 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Price whose telephone number is 703-308-2694. The examiner can normally be reached on Monday through Friday from 8:30a.m. to 5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poon can be reached on 703-308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Thomas Price
Primary Examiner GAU: 3643

rtp